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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,147	09/09/2003	Norie Matsui	117067	1900
25944	7590	04/07/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			ASSAF, FAYEZ G	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/657,147	Applicant(s) MATSUI ET AL.	
	Examiner Fayez G. Assaf	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 9-16 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II: claims 9-16 in the reply filed on 2/28/2005 is acknowledged.

Claim Objections

Claims 9-16 are objected to because of the following:

Claim 9, on line 2, 8 and 11, the language recites the phrase "can be" which only requires the ability to so perform.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al. (US 5,162,927).

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Regarding claims 9, 11 and 14, Moss discloses an optical recording medium comprising a plurality of recording (18 of Fig. 3, line 61 to line 64 of Col. 8) layers on which information is recorded holographically, wherein the recording layers each contain photo-isomerizable components that record holograms through photo-isomerization, and intermediate layers (10 of Fig. 3), each of which contains photoisomerizable components which is isomerized by radiation having a same wavelength as radiation used for isomerizing the photo-isomerizable component contained in the recording layer and is composed of a material composed of a material (the gelatin) that is one of dissolved or dispersed in a solvent (moisture content of the film, line 33 to line 50 of Col. 3) that does not dissolve the recording layer, are laminated alternately, in the optical recording medium.

Moss discloses the claimed invention except for the substrate being a disc-shaped substrate.

However, holographic mediums of such shapes are well known in the art.

It would have been obvious, at the time the invention was made, to a person having ordinary skill in the art to utilize such disk-shaped substrate in order to adapt the holographic medium to be used in holographic CD devices.

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Regarding claims 13 and 16, Moss disclose the laminated film constituted by the recording layers and the intermediate layers having a thickness of at least 10 micrometers (line 31 to line 32 of Col. 3).

Regarding claim 12 and 15, Moss discloses the claimed invention except for the intermediate layer being thinner than the thickness of the recording layer or the photo-isomerizable organic molecules being azobenzene.

However, the proper choice of material for the intended use or the determination of optimal thickness can be achieved by routine experimentation, which does not serve as basis for patentability.

It would have been obvious, at the time the invention was made, to a person having ordinary skill in the art to utilize such material and/or relative optical thicknesses so as to improve diffraction efficiency.

Furthermore, it has been held to be within the ordinary skill of worker in the art to select a known material on the basis of its suitability for the intended use. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Colvin et al. (US 6,322,932 B1)

Yu et al. (US 5,282,066)

Wu et al. (US 2003/0156523 A1)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fayez G. Assaf whose telephone number is (571) 272-2307. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fayez G. Assaf
Primary Examiner
Art Unit 2872

4/4/2005